Remarks

With entry of this amendment, claims 1-8 and 10-33 are pending in this application with claim 1 being the only independent claim. By the foregoing amendments, claim 1 is sought to be amended and is presented for reconsideration. These changes are believed not to introduce new matter and their entry is respectfully requested. Support for the amendment to claim 1 is found, among other places, in the Summary section of the specification on p. 3, lines 15-27.

Rejection under 35 U.S.C. § 103(a)

Claims 1-8, 21, 22, and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO91/19856 (*Johansson*) in view of GB2030197A (*Williams et al.*).

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johansson* and *Williams et al.* and further in view of U.S. 5,639,179 (*Jensen*).

Claims 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johansson* and *Williams et al.* and further in view of U.S. 5,513,924 (*Alghunaim*).

Claims 14, 15, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johansson* and *Williams et al.* and further in view of U.S. 5,703,719 (*Chen*).

Claims 16 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johansson* and *Williams et al.* and further in view of U.S. 5,710,558 (*Gibson*).

Claims 17 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johansson* and *Williams et al.* and further in view of U.S. 5,630,674 (*Inaba*).

Claims 18-20, 29, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johansson* and *Williams et al.* and further in view of U.S. 3,798,743 (*Griswold*).

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johansson* and *Williams et al.* and further in view of U.S. 6,102,612 (*Pricone*).

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johansson* and *Williams et al.* and further in view of U.S. 6,032,684 (*Narron*).

Claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johansson*, *Williams et al.*, and *Griswold*, and further in view of U.S. 5,710,558 (*Gibson*).

Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Johansson* and *Williams et al.* and further in view of U.S. 6,174,103 (*Stroman*).

As amended herein, Claim 1 contained the following elements and limitations:

> 1) a plurality of speed bump cells, each said speed bump cell being a block having a bottom and a top surface, said top surface starting at a front edge of said bottom, rising to a top point above said bottom, and falling to a back edge of said bottom; and
>
> 2) a means for pivotally interconnecting said plurality of speed bump cells, such that each of said plurality of speed bump cells abuts a speed bump cell adjacent thereto thereby creating a longitudinal axis of the portable speed bump unit, and wherein said means for pivotally interconnecting is located between two adjacent speed bump cells and extends in a direction transverse to the longitudinal axis of the portable speed bump unit.

In order to establish a prima facie case of obviousness, the combined teachings of *Johansson* and *Williams et al.* must teach, among other things, a means for pivotally interconnecting said plurality of speed bump cells, such that each of said plurality of speed bump cells abuts a speed bump cell adjacent thereto. *See* MPEP 2143 (the prior art reference, or references when combined, must teach or suggest all the claim limitations).

Johansson is cited as teaching a vehicle speed restriction device having a number of interconnected profile bodies, wherein the profile bodies are hingedly connected by chain links. The chain links are cited as teaching or suggesting the pivotally interconnecting means of Applicant's claim 1. As admitted in the Office Action, *Johansson* does not teach or suggest each of the profile bodies abutting a profile body adjacent thereto - this is because the chain links separate the profile

bodies. *Williams et al.* is relied upon for teaching or suggesting the limitation of a plurality of speed bump cells (or blocks) each abutting a speed bump cell adjacent thereto. It is thus asserted that the teachings of *Johansson* (pivotally interconnecting means) and *Williams et al.* (plurality of cells each abutting a cell adjacent thereto), when combined, teach all of the limitations of claim 1.

Assuming for sake of argument that the combined teachings of *Johansson* and *Williams et al.* do teach of the limitations of claim 1, there also must be some motivation or suggestion to combine or modify the references in order to establish prima facie obviousness. *See* MPEP 2143 (there must be some suggestion or motivation to modify the reference or to combine reference teachings). Thus, there must be some suggestion or motivation to replace the chain links of the *Johansson* device with the plug or plugs taught by *Williams et al.*, thereby causing each of the plurality of cells to abut a cell adjacent thereto. Because there is no such suggestion or motivation, a prima facie case of obviousness has not been established.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See* MPEP 2143.01 *citing In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). The device in *Johansson* is designed to allow a user to restrict vehicle speed at various locations, regardless of the road condition, with a single device. *Johansson* states:

> The road vehicle speed restriction device in accordance with the invention is a comparatively light construction and when the road work is completed, it may easily be lifted by one or a couple of workers and be transported to the next road section, where new road repairs are to start. Owing to the construction, having a large surface in engagement with the roadway surface 7 and using chain links 10 as the body interconnection means, ***the speed restriction device remains firmly in position in the longitudinal direction of the road while at the same time it adjusts itself to any surface unevenness in the transverse direction of the roadway.***

Johansson, p. 3, lines 31-37; p. 4, lines 1-5 (emphasis added). The chain links are an integral component of the *Johansson* speed restriction device, because the chain links provide the structural

flexibility which allows the device to adapt and conform to the road surface regardless of its condition, *i.e.*, evenness or unevenness. To replace the chain links of *Johansson* with a plug or plugs extending the length of the profile bodies as taught in *Williams* would eliminate the flexibility between the *Johansson* profile bodies. To do so would prevent the *Johansson* device from being able to adjust to road unevenness, thereby making the device unsatisfactory for its intended purpose, *i.e.*, to provide a portable vehicle restriction device that can be transported easily and that can be used in various situations regardless of the road conditions. Because modifying the *Johansson* device according to the teaching of *Williams* would render the *Johansson* device unsatisfactory for its intended purpose, there is no suggestion or motivation to modify *Johansson* or to combine *Johansson* and *Williams*. Absent such a motivation, a prima facie case of obviousness has not been established. Accordingly, Applicant respectfully requests withdrawal of the obviousness rejection of claim 1.

Alternatively, there is no suggestion or motivation to modify or combine the references because modifying *Johansson* by replacing the chain links with a plug or plugs would change the principle of operation of the *Johansson* device. *See* MPEP 2143.01 (if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious). As discussed above, the flexibility provided by the chain links allows the *Johansson* device to be used in varying conditions because the device can conform to the surface on which the device is placed, thereby keeping a large surface area of the device in contact with the roadway. To replace the flexible chain links with the rigid plugs of *Williams* would eliminate this need for flexibility and change the principle of operation of the *Johannson* device. Therefore, there is no suggestion or motivation to combine the teachings of *Williams* with those of *Johansson*.

To further identify that which Applicant claims as his invention and to clarify the differences between Applicant's invention and the teachings of *Johansson* and *Williams*, Applicant has amended claim 1 by clarifying that the pivotally interconnecting means runs in a direction transverse to the longitudinal axis of the cells of the portable speed bump unit. In sharp contrast, both the chain links

in *Johansson* and the plug or plugs in *Williams* extend in a direction parallel to the longitudinal axis of these speed control devices when in an extended position. Thus, neither *Johansson* nor *Williams* teaches a pivotally interconnecting means extending in a direction transverse to the direction in which the speed control unit extends. In fact, both *Johansson* and *Williams* teach away from Applicant's invention. Based on the foregoing, Applicant respectfully asserts that amended claim 1 is not obvious in light of the combined teachings of *Johansson* and *Williams*. Withdrawal of this rejection is respectfully requested.

Regarding dependent claims 2-8 and 10-33, it is well established in the patent law "that allowance of a parent or base claim as patentable normally results in allowance of a claim dependent upon that claim." *See* DONALD S. CHISUM, CHISUM ON PATENTS § 7.04[2]; *U.S. v. Telectronics, Inc.*, 658 F. Supp. 579, 591, 3 USPQ2d 1571, 1580 (D. Colo. 1987), *aff'd in part and rev'd in part*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988), *cert. denied*, 109 S. Ct. 1954 (1989)("Since it would not have been obvious to have made the invention defined in claim 1, ... it would not have been obvious to make the inventions defined in dependent claims 3, 4 and 5."); *In re Fine*, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.").

As discussed above, Applicant respectfully submits that amended, independent claim 1 is patentably distinguishable and non-obvious over the prior art, and thus is in proper condition for allowance. Since it would not have been obvious to make the invention claimed in amended claim 1, it would not have been obvious to make the inventions defined in dependent claims 2-8 and 10-33, which are narrower than amended independent claim 1. *See* MPEP 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious."). Applicant respectfully submits that claims 2-8 and 10-33, like amended independent claim 1, are in proper condition for allowance. Withdrawal of the rejection of these claims is respectfully requested.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

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